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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,669	12/21/2000	Brian M. Siegel	50N3787	5754
27774	7590	01/10/2006	EXAMINER	
MAYER, FORTKORT & WILLIAMS, PC 251 NORTH AVENUE WEST 2ND FLOOR WESTFIELD, NJ 07090			RHODE JR, ROBERT E	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/745,669	Applicant(s) SIEGEL ET AL.	
	Examiner Rob Rhode	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5 - 7, 28 and 31 - 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5 - 7, 28 and 31 - 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant amendment of 10-19-05 amended claims 1 and 7 as well as canceled claims 2 – 4, 8 – 27, 29 – 30 and 33 – 41.

Currently, claims 1, 5 – 7, 28 and 31 – 32 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5 – 7, 28 and 31 – 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schena (US 6,448,979 B1) in view of Kocher (US 6,652,455 B1).

Regarding claim 1, 7 and 28. (Currently Amended), Schena teaches a method for retrieving information related to a consumer product comprising the steps of: integrating a bar code scanner and a removable memory into a consumer good, wherein said consumer good comprises a non-electronic device; scanning a bar code of a selected consumer product using the integrated scanner and storing the scanned bar code; transferring the scanned bar code to a computer network; and

Art Unit: 3625

accessing a web site one the computer network based on the scanned bar code, wherein said web site includes information related to the selected consumer product (see at least Col 3, lines 42 – 63, Col 4, lines 32 – 37, Col 5, lines 34 – 39 and Col 6, lines 27 – 36).

While Schena does disclose storing of the scanned bar code/data in an enhanced device such as key chain or a smart card, in which the scanner is incorporated/integrated, the reference does not specifically disclose and teach a removable memory.

On the other hand and in the same area of storing data in a scanning device, Kocher teaches storing the data in a removable memory (Col 5, lines 27 -30).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the apparatus and method of Schena with the apparatus and method of Kocher to meet the claim limitations of claim 28. Schena discloses a method and apparatus for retrieving information related to a consumer product comprising the steps of: integrating a bar code scanner and a removable memory into a consumer good, wherein said consumer good comprises a non-electronic device; scanning a bar code of a selected consumer product using the integrated scanner and storing the scanned bar code; transferring the scanned bar code to a computer network; and accessing a web site one the computer network based on the scanned bar code, wherein said web site

Art Unit: 3625

includes information related to the selected consumer product (see at least Col 3, lines 42 – 63, Col 4, lines 32 – 37, Col 5, lines 34 – 39 and Col 6, lines 27 – 36). In turn, Kocher discloses a method and apparatus for storing the data in a removable memory of a scanner (Col 5, lines 27 – 30). Therefore, one of ordinary skill in the art would have been motivated to extend the method and apparatus of Schena with a method and apparatus for storing the data in a removable memory of a scanner – in order to provide an old and well known option.

Regarding claim 5 (Currently Amended), Schena teaches an apparatus, wherein said non- electronic device comprises one of the following: an article of clothing, a pen and a pocketbook (Col 3, line 53).

Regarding claim 6 (Original), Kocher teaches an apparatus, wherein said removable memory medium comprises one of the following: a magnetic disc, flash memory, a smart card, a memory stick, a diskette, a CD-ROM, a disk drive, a random access memory chip, and an optical storage device (Col 5, lines 27 – 30). Please note that Kocher does not specifically disclose a smart card. However, Schena does disclose a smart card. In that regard, it would have been obvious to one of ordinary skill in the art at the time of the invention to have extended the removable memory disclosed by Kocher, with removable memory such as a smart card.

Art Unit: 3625

Regarding claim 31 (Original), Schena teaches a method, further comprising converting a scanned bar code to a uniform resource locator of a web site (Col 4, lines 32 – 37).

Regarding claim 32 (Original), the recitation “further comprising converting a scanned bar code and a global position to a uniform resource locator (URL) of a web site), such recitation is given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other “converting” already disclosed by Schena.

Response to Arguments

Applicant's arguments filed 10-19-05 have been fully considered but they are not persuasive.

Applicant argues there is no motivation to combine the references since Schena only teaches a data transfer via communication link and teaches away from using removable medium/memory.

First and in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one

Art Unit: 3625

of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the problem to be solved is to store information in a scanning and storage device and then transfer/transmit the stored information. In that regard, Schena discloses and teaches one of ordinary skill in the art of storing information from a scanner (Col 5, lines 37 - 38). Moreover, Schena further discloses a method of transmitting this stored information at later time. In that regard, it was also old and well known to one of ordinary skill in the art that an early option for implementing memory was to use removable memory in these mobile applications. Thereby and while Schena teaches "a way", one of ordinary skill would have also known of "a way" of implementing this memory using removable medium in these applications as taught by Kocher. Therefore, one of ordinary skill would have been motivated to extend the method of Schena with a method for storing information on removable medium and thereby provide an additional option for storing and then transmitting the information.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art is Jigour (US 2001/0038547), which teaches an early option for these mobile devices included removable medium (see Para 0041).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **571.272.6761**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **571.272.7159**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:


(703) 872-9306 [Official communications; including
After Final communications labeled
"Box AF"]

For general questions the receptionist can be reached at
571.272.3600

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Jeffrey A. Smith
Primary Examiner